UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,640	12/14/2001	William R. Matz	36968/265387	9378

30314 7590 02/26/2003

JOHN S. PRATT
KILPATRICK STOCKTON LLP (BELLSOUTH)
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

EXAMINER
OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/017,640	MATZ ET AL.	
	Examiner	Art Unit	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 December 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

   A person shall be entitled to a patent unless –

   (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 6, 10-13, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Carles (US 5,661,516)

3. As per independent Claims 1, 16, and 17, Carles discloses a method (computer-readable medium, system) for utilizing information relating to a subscriber to identify said subscriber as a desirable subscriber comprising: receiving content-access information associated with a subscriber; receiving a subscriber attribute; merging said content-access information and said subscriber attribute to create a subscriber information data store; and analyzing said subscriber information data store to determine said subscriber's desirability in relation to a provider (Abstract, Fig.1, Figs.3-4, C1 L55-67, C2 L1-11, C3 L29-62, C4 L66-67, C5-C8, Claims 4-5).

4. As per Claim 6, Carles discloses wherein said subscriber attribute comprises demographic information (Abstract, Fig.1, Figs.3-4, C1 L55-67, C2 L1-11, C3 L29-62, C4 L66-67, C5-C8, Claims 4-5).

5. As per Claim 10, Carles discloses wherein said subscriber attribute comprises a purchase (Abstract, Fig.1, Figs.3-4, C1 L55-67, C2 L1-11, C3 L29-62, C4 L66-67, C5-C8, Claims 4-5).

6. As per Claim 11, Carles discloses wherein said purchase comprises a purchase of a product, wherein said product complements a product provided by said provider (Abstract, Fig.1, Figs.3-4, C1 L55-67, C2 L1-11, C3 L29-62, C4 L66-67, C5-C8, Claims 4-5).

7. As per Claim 12, Carles discloses wherein said purchase comprises a purchase of a product, wherein said product competes with a product provided by said provider (Abstract, Fig.1, Figs.3-4, C1 L55-67, C2 L1-11, C3 L29-62, C4 L66-67, C5-C8, Claims 4-5).

8. As per Claim 13, Carles discloses wherein said provider comprises a content provider (Abstract, Fig.1, Figs.3-4, C1 L55-67, C2 L1-11, C3 L29-62, C4 L66-67, C5-C8, Claims 4-5).

9. As per Claim 18, Carles discloses wherein said subscriber attribute database comprises a purchase history database (Abstract, C4 L66-67, C5-C8, Claims 4-5).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claim 2-5, 7-9, 14, 15, and 19-24 are rejected under 35 U.S.C. 103 as being unpatentable over Carles.

12. As per Claim 2, Carles does not expressly show wherein said subscriber comprises a consumer.

13. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of subscriber used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

14. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have performed the method (computer-readable medium, system) on a consumer subscriber, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the subscriber does not patentably distinguish the claimed invention.

15. As per Claims 3-5, Carles does not expressly show wherein said content-access information comprises television programming data, advertising data, and duration information.

16. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of content-access information used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
17. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using television programming data, advertising data, and duration information as the content-access information, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the content-access information does not patentably distinguish the claimed invention.
18. As per Claims 7 and 8, Carles does not expressly show wherein said demographic information comprises a profession of said subscriber or a property ownership history of said subscriber.
19. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of demographic information used. Thus, this descriptive material will not distinguish the

claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using a profession of said subscriber or a property ownership history of said subscriber as the demographic information, because such information does not functionally relate to the steps in the method claimed and because the subjective interpretation of the demographic information does not patentably distinguish the claimed invention.
21. As per Claim 9, Carles does not expressly show wherein said subscriber attribute comprises a questionnaire response.
22. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of subscriber attribute used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using a questionnaire response as a subscriber attribute, because such an attribute does not

functionally relate to the steps in the method claimed and because the subjective interpretation of the subscriber attribute does not patentably distinguish the claimed invention.

24. As per Claims 14 and 15, Carles does not expressly show wherein said content provider comprises a programming provider or an advertising provider.

25. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of content provider used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

26. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using a programming provider or a advertising provider as a content provider, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the content provider does not patentably distinguish the claimed invention.

27. As per Claim 19, Carles does not expressly show wherein said purchase history database comprises a credit card database.

28. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of purchase history database used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

29. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using a credit card database as a form of purchase history database, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the purchase history database does not patentably distinguish the claimed invention.

30. As per Claims 20 and 21, Carles does not expressly show wherein said subscriber attribute database comprises a property ownership database or a survey results database.

31. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of subscriber attribute database used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d

1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

32. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using a property ownership database or a survey results database as a subscriber attribute, because such an attribute does not functionally relate to the steps in the method claimed and because the subjective interpretation of the subscriber attribute database does not patentably distinguish the claimed invention.

33. As per Claims 22-24, Carles does not expressly show wherein said data analyzer comprises a report creator, a multidimensional database, or a data-mining application.

34. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of data analyzer used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

35. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using a report creator, a multidimensional database, or a data-mining application as a data analyzer, because such data does not functionally relate to the steps in the method

claimed and because the subjective interpretation of the data analyzer does not patentably distinguish the claimed invention.

Conclusion

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

37. The following foreign patent is cited to show the best foreign prior art found by the examiner:

European Pat. No. EP 1162840 A2 to Wilson et al.

Wilson discloses a method and apparatus for delivering targeted assets to subscribers using communication media, wherein each subscriber has a set top box, the method comprising the steps of generating a profile of each subscriber at the set top box associated with the respective subscriber, broadcasting an asset to all subscribers along with target information; and delivering the asset only to subscribers whose profiles match the target information.

38. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

Reed, David, "The future is digital. (interactive digital TV offers marketing opportunities)," Precision Marketing, v13, n51, p27, September 21, 2001.

Reed discloses marketing techniques used with interactive digital TV, to include capturing customer data and delivering a brand experience.

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

40. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

41. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

jo
February 19, 2003

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600